

REMARKS

Claims 35-42 are currently pending in the application. Claims 1-8, 30-34, 43, and 44 have been withdrawn from consideration by the Examiner as allegedly being directed to a non-elected invention. No claims stand allowed. Claim 35 has been amended. No new matter has been added. Support for the claim amendments may be found at, for example, paragraphs [0083] and [0075] through [0077] of the published application.

Information Disclosure Statement

Applicants request that the Examiner consider the patent to Kelly (6,306,035), submitted in the Information Disclosure Statement of October 27, 2005. Applicants' representative does not see an indication in the file history of this reference being considered.

Restriction Requirement

Claims 43 and 44 have been withdrawn by the Examiner as allegedly being directed to an invention that is independent or distinct from the invention originally claimed.

Applicants respectfully traverse the restriction requirement and request that the Examiner reconsider in light of the arguments presented herein. Claim 44 included both previously presented features related to determining a new percentage of an incoming wager amount to be applied to the progressive, as recited in previously presented claim 35, for example, and newly submitted features related to registering a gaming system for participation in a progressive game.

Table 1 below compares previously presented claim 35 to restricted claim 44, which included the features of currently amended claim 35.

Table 1 – Features of Prior Claim 35 vs. Amended Claim 35

	Claim 35, without features of claim 44	Clam 35, As amended herein with features of restricted claim 44
1	A system for managing a progressive jackpot, comprising:	A system for managing a progressive jackpot, comprising:
2	a progressive management device including: an interface; and	a progressive management device including: an interface; and
3	a progressive engine for maintaining a progressive game	a progressive engine for maintaining a progressive game
4	the progressive management device being coupled by the interface to a first gaming system and a second gaming system	the progressive engine being coupled by the interface to a first gaming system and a second gaming system
5	the first gaming system including a first set of progressive payout parameters and the second gaming system including a second set of progressive payout parameters that is different from the first set of progressive payout parameters	the first gaming system including a first set of progressive payout parameters and the second gaming system including a second set of progressive payout parameters that is different from the first set of progressive payout parameters
6	the first set of progressive payout parameters including a first wager amount necessary to participate in the progressive game and first odds of winning the progressive game, and the second set of progressive payout parameters including a second wager amount necessary to participate in the progressive game and second odds of winning the progressive game	the first set of progressive payout parameters including a first wager amount necessary to participate in the progressive game and first odds of winning the progressive game, and the second set of progressive payout parameters including a second wager amount necessary to participate in the progressive game and second odds of winning the progressive game
7	the progressive management device operable to:	the progressive management device operable to:
8	1) receive incoming wagers from the first gaming system wherein each of the incoming wagers includes an incoming wager amount and wherein a portion of the incoming wager amount is to be applied to the progressive jackpot	1) receive incoming wagers from the first gaming system wherein each of the incoming wagers includes an incoming wager amount and wherein a portion of the incoming wager amount is to be applied to the progressive jackpot
9	2) determine the second odds of winning the progressive jackpot such that a ratio of the	2) determine the second odds of winning the progressive jackpot such that a ratio of the

	first wager amount necessary to participate in the progressive jackpot to the first odds of winning the progressive jackpot is equal to a ratio of the second wager amount necessary to participate in the progressive jackpot to the second odds of winning the progressive jackpot	first wager amount necessary to participate in the progressive jackpot to the first odds of winning the progressive jackpot is equal to a ratio of the second wager amount necessary to participate in the progressive jackpot to the second odds of winning the progressive jackpot
10	3) for each of the incoming wagers comparing the odds of winning the progressive jackpot to a random number to determine whether the progressive jackpot is won.	3) for each of the incoming wagers comparing the odds of winning the progressive jackpot to a random number to determine whether the progressive jackpot is won.
11		progressive management logic configured to do the following:
12		initiate at least one transmission to at least one potential client system, wherein the at least one transmission solicits participation of the at least one potential client system in the progressive game
13		receive at least one request from at least one gaming system to participate in the progressive game, wherein the at least one request includes information describing characteristics of the gaming system seeking participation, including progressive payout parameters
14		register the at least one gaming system for participation in the progressive game in response to a request to activate a new game to link to a progressive award.

TRAVERSAL OF THE PENDING RESTRICTION REQUIREMENT

It is respectfully submitted that the pending restriction requirement is not in accordance with the standing policies of the United States Patent and Trademark Office as set forth in the M.P.E.P. Accordingly, reversal of the pending restriction requirement is respectfully requested.

Under M.P.E.P. § 803, the criteria for restriction between patentably distinct inventions require the Examiner to show that (1) the inventions are independent as described in M.P.E.P. §§ 802.01, 806.06 and 808.01, or distinct as claimed as described in M.P.E.P. §§ 806.05 through

806.05(j); *and* (2) a serious burden would be placed on the Examiner if restriction was not required. The Examiner must provide reasons and or examples to support his or her conclusions. Furthermore, if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions. MPEP 803. Applicant respectfully submits that there is no serious burden in this case because, for example, the pending claims had already been withdrawn, so there would have been no serious burden in examining claims 43 and 44. Applicant disagrees with the Examiner's classification of claims 43 and 44 into class 463/29, and believes that claim 44 should correctly be classified in the same class as the previously presented claims, i.e., 463/27 because the subject matter of claims 43 and 44 is related to progressive jackpot games, which are classified in 463/27. Furthermore, claim 44 is not restrictable because it contains a subcombination essential to the combination, as described below. Therefore, the Examiner must examine the features of withdrawn claim 44, now in amended claim 35, on the merits.

Claim 44 includes a subcombination essential to a combination, and therefore should not have been subject to a restriction requirement. In particular, claim 44 includes several features designated herein as "Z" in addition to the features "Y" that are separately claimed in claim 44. As illustrated in Table 2 below, the label Y refers to features 2-10 of claim 1, and the label Z refers to features 11-16 of claim 1. Certain amendments were made to the features Y on 8/5/2009; those amendments were not referenced by the Examiner in the restriction requirement. As best understood, the addition of features Z to claim 1 led to the restriction requirement, and the amendments to Y were not restricted from the previously presented features Y. Features Y and Z are shown in Table 2 below. Features Z have been added to claim 35 in this amendment.

Table 2 – Summary of Features of Claim 35

Features	Previously presented claim 35	Newly submitted claim 35
1	A system for managing a progressive jackpot, comprising:	A system for managing a progressive jackpot, comprising:
2-10	Y.	Y; and
11-14		Z.

Newly submitted claim 35 includes essentially all of the features Y of the previously presented claims, plus the features Z.

The conditions under which a restriction requirement may properly be made are set forth in M.P.E.P. 806.05, as follows:

806.05 Related Inventions

Where two or more related inventions are claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the

ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. *If they are not distinct, restriction is never proper.*

M.P.E.P. 806.05 (emphasis added).

The inclusion of features Z in claim 44 did not create the distinctness needed for a restriction requirement, at least in the sense of the term “distinct” as used in M.P.E.P. § 806. Newly submitted claim 35 also includes those features Z. In particular, M.P.E.P. § 806.05(c) states:

806.05(c) Criteria of Distinctness Between Combination and Subcombination

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search. M.P.E.P. 806.05(c).

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), **and**

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct.
M.P.E.P. 806.05(c) (emphasis added).

Item I of M.P.E.P. 806.05(c) describes the case of a subcombination essential to a combination, in which a restriction should not be made. Claim 44 corresponds to this case for the reasons given below. Item I of M.P.E.P. 806.05(c) is reproduced here:

I. SUBCOMBINATION ESSENTIAL TO COMBINATION

AB_{sp}/B_{sp} No Restriction

Where a combination [AB_{sp}] as claimed requires the details of a subcombination [B_{sp}] as separately claimed, *there is usually no evidence that* combination AB_{sp} is patentable without the details of B_{sp}. *The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.* This situation can be diagrammed as combination AB_{sp} ("sp" is an abbreviation for "specific"), and subcombination B_{sp}. Thus the specific characteristics required by the subcombination claim B_{sp} are also required by the combination claim.

M.P.E.P. 806.05(c), emphasis added

This case of a subcombination essential to a combination can be understood as follows: If a claim recites features B_{sp} (e.g., features Y in previously presented claim 1), and another claim recites features AB_{sp} (e.g., features Y and Z in newly submitted claim 1), and if the claim to B_{sp} is assumed to be allowable (for the purposes of deterring whether to make a restriction), then the claim to AB_{sp} is also allowable, since AB_{sp} includes the allowable features B_{sp} , so there should be no restriction between the two claims.

In the instant application, the features Y of claim 1 correspond to B_{sp} and the newly-submitted features Z correspond to A. The previously presented claim 1 corresponds to B_{sp} . Therefore, the newly submitted claim 1 corresponds to AB_{sp} . In this situation, M.P.E.P. 806.05(c) states that a restriction must not be made, even if the subcombination has separate utility.

In the instant application, the features of claim 1 prior to the amendment, i.e., features Y in the chart above, are the subcombination B_{sp} , and the features added in the amendment, i.e., features Z, are A. Claim 35 is the combination AB_{sp} , and the combination/subcombination example of M.P.E.P. 806.05(c) applies to claim 35 (and withdrawn claim 44). The two-way distinctness requirement for restriction under 806.05(c) is thus not met, and the restriction requirement should be withdrawn. Therefore, according to MPEP 806.05(c), had they been presented together when originally filed, claim 44 could not have been restricted from previously pending claim 35 (or claim 1 as originally filed).

MPEP 821.03 specifically prohibits restriction by original presentation in this situation.

The practice set forth in this section is not applicable where a provisional election of a single species was made in accordance with MPEP § 803.02 and applicant amends the claims such that the elected species is cancelled, or where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.

MPEP 821.03, last paragraph.

Therefore, the restriction requirement should be withdrawn.

Rejection under 35 U.S.C. 112

Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner indicates that the feature “determine a new percentage of the incoming wager amount to be applied to the progressive jackpot, an odds

of winning the progressive jackpot, and the new percentage of the incoming wager amount to be applied to the progressive jackpot is equal for the first and second gaming systems” is incorrect and would result in a system that does not equalize the contribution amounts to a progressive for different wager amounts.

Claim 35 has been amended to recite a system comprising a progressive management device operable to determine the second odds of winning the progressive jackpot such that a ratio of the first wager amount necessary to participate in the progressive jackpot to the first odds of winning the progressive jackpot is equal to a ratio of the second wager amount necessary to participate in the progressive jackpot to the second odds of winning the progressive jackpot. Applicants respectfully submit that the system of claim 35 correctly equalizes the contribution amounts to a progressive, and request that the section 112 rejection be withdrawn.

Rejection under 35 U.S.C. 103(a)

Claims 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy; Daniel A. (US 5,116,055 A, hereinafter “Tracy”) in view of Vancura, Olaf et al. (US 20030181231). These rejections are respectfully traversed.

Applicants respectfully submit that none of the art relied upon describes or suggests a progressive game management device as recited in amended claim 35. For example, none of the cited art describes or suggests progressive management logic configured to initiate at least one transmission to at least one potential client system, wherein the at least one transmission solicits participation of the at least one potential client system in the progressive game, as is recited in claim 35. Further, none of the cited art describes or suggests logic configured to receive at least one request from at least one gaming system to participate in the progressive game, wherein the at least one request includes information describing characteristics of the gaming system seeking participation, including progressive payout parameters. Still further, none of the cited art describes or suggests logic configured to register the at least one gaming system for participation in the progressive game in response to a request to activate a new game to link to a progressive award. Hence, new claim 35 is patentable over the cited references.

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations herein are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

If any fees are due in connection with the filing this Response to Restriction Requirement, the Commissioner is hereby authorized to charge such fees to Deposit Account 504480 (Order No. IGT1P395).

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